UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 13

Application Number: 09/449,707
Filing Date: November 24, 1999
Appellant(s): CONSTANTINO ET AL.

Jack P. Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 19, 2003.

(1)   *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly

affect or be directly affected by or have a bearing on the decision in the pending appeal

is contained in the brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5)   ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6)   ***Issues***

The appellant's statement of the issues in the brief is correct.

(7)   ***Grouping of Claims***

Appellant's brief includes a statement that claims 1-21 do not stand or fall

together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   ***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   ***Prior Art of Record***

| 4,831,526 | LUCHS ET AL. | 5-1989 |
| 6,067,531 | HOYT ET AL. | 5-2000 |

| 5,692,206 | SHIRLEY ET AL. | 11-1997 |
| 5,272,623 | GRUBB ET AL. | 12-1993 |

"Frequently Asked Questions About Your Virtual Agent Network for World Wide

Business!", Australian American Chamber of Commerce, 1996, p.20.,

"www.an2acc.com/VirtualAgent FAQ.htm" (provided by Applicant in IDSfiled 11/24/99)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 6-7, 9, 12-13, 15, 18, 19, 21 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Luchs et al in view of Hoyt et al and further in view of Shirley et

al.

Claims 2, 8, 14 are rejected under 36 U.S.C. 103(a) as being unpatentable over

Luchs et al. in view of Hoyt et al. and Shirely et al. as applied to claims 1, 7 and 13 and

further in view of "Frequently Asked Questions About Your Virtual Agent Network for

World Wide Business!", Australian American Chamber of Commerce, 1996, p.20.,

"www.an2acc.com/VirtualAgent FAQ.htm".

Claims 4-5, 10-11, 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Luchs et al in view of Hoyt et al and further in view of Shirley et al

and further in view of Grubb et al.

This rejection is set forth in prior Office Action, Paper No. 8

(11) Response to Argument

The pages 6-12 of the Brief are directed to the Appellant's argument with respect to the rejection of Claims 1, 7 and 13. There are five examples of arguments presented by the Appellant.

As per the first example, Applicant argues that "Luchs's system does not include model agreements (i.e., model contracts) as required by claims 1, 7 and 13, but instead includes a database of stored paragraphs, such that an insurance agreement(i.e., insurance contract) may be formed from the selection of particular paragraphs from the database of paragraphs." Examiner disagrees with this characterization. Referring to the actually claimed limitation, in Claim 1, line 4, "selecting and merging all or part of said one or more model agreements into a contract in response to said client requests." Compare that limitation with Luchs in col. 4, line 17, "separate and complete paragraphs are sequenced ...to yield an insurance contract." Firstly, it must be noted that the "model agreement" is not "model contracts" as Appellant argues. Rather, the claim states that the model agreements are merged into a contract. This is exactly what is shown by Luchs as explained in col.4, line 17.

As per the second example, on pages 8 and 9, Appellant agues that Appellant argues that "an individual paragraph is not a model agreement, as explained supra in conjunction with the First example." Examiner disagrees with this analysis. In reference to the first example, the only argument provided by the Appellant is that "Luchs never referes an insurance contract as consisting of only one of said paragraphs. Thus, Appellants respectfully suggest that the Examiner's assumption that one of Luchs' stored paragraphs could be a complete contract is unsupported speculation." Again, this

argument is moot with respect to the claimed feature. Note that in Claim 1, line 4, what is claimed is "selecting and merging all or part of <u>said one or more model agreements</u> into a contract in response to said client requests." Nothing in the claim requires that Luchs must show processing "one" agreement **and** "more than one" agreements. The limitation is in an alternative form, which allows Luchs to show either instance. Therefore, if the Appellant argues that Luchs contract must have more that one paragraphs, that also perfectly meets the claimed limitation.

As per the third example, Appellant argues that "it is not obvious to modify Luchs to include a repository in which to store the tracking information associated with the contract, because Luchs is concerned only with processing insurance application and generating insurance contracts therefrom. Luchs is not concerned with tracking information associated wit the generated insurance contract. In response to applicant's argument that Luchs is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hoyt teaches the capability for "tracking" any contracts and Luchs teaches creating "insurance contracts." It is clear that a person of ordinary skill in the art would have appreciated the benefit of Hoyt in processing any types of contracts to the processing of the specific type of contract in Luchs.

In reference to the fourth example, Applicant argues that "[i]mportantly, the reinstatement mechanism disclosed in Luchs, col.2, lines 43-46 is simple and apparently works without the need to add the unnecessary complexity of Shirley's tracking date." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Luchs system may be "simple" but teaches what is claimed and the rationale for the combination with the Hoyt and Shirely has been sufficiently provided.

As per the fifth example, Appellant argues that "While the Examiner has made arguments relating to the storing of tracking data and the tracking dates, the Examiner has made not made any argument relating to processing key date reminders and approvals into tracking data." Examiner points to the fact that the claims define the invention, and the claim calls for "processing ...,into tracking data." Thus, "storing the data... along with the tracking data" is a form of "processing."

With respect to Claim 13 on page 13 of the Brief, Appellant argues that the Examiner's rejection is "generic and non-specific". The rejection states that claim 13 is for a computer readable medium comprising the method of claim 1, and thus, the use of the computer readable medium would have been obvious to a person of ordinary skill in the art at the time of the invention. Examiner cannot understand why the argument is "generic and non-specific." Clearly, Luchs, Hoyt and Shirely disclose the computer implemented methods. Since the instructions (e.g., software) must reside in a computer

readable medium in order to be executed by the computers, any computer implemented

methods being stored in a computer readable medium would be inherently or at least

would have been obvious to a person of ordinary skill in the art at the time of the

invention.

On page 14 and 15, Appellant argues that "it is improper to argue that a feature

is taught or suggested by a secondary reference through modification of another

secondary reference. If the Examiner could modify a secondary reference in the

preceding manner, then the Examiner would be able to show the existence of any

element or feature of any claim merely by chaining a sufficient number of secondary

references together ..." The argument is not persuasive. There is not requirement

limiting how many references can be used, or how they must be combined. In response

to applicant's argument that the examiner has combined an excessive number of

references, reliance on a large number of references in a rejection does not, without

more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933

F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

On pages 15 and 16, with respect to claims 6, 12 and 18, Appellant asserts that

"Shirley's 'supplemental provisions' are essential the same as Luchs' paragraphs.

Therefore there is not need to modify Luchs by Shirley to add supplemental provisions."

The argument is not persuasive. Shirley would have given an additional tailoring

capability which is clearly a motivation.

On page 17, with respect to claims 19 and 21, Appellant argues that the Examiner rejection is "generic and non-specific." As explained with respect to claim 13 above, the argument is not persuasive.

On pages 18-19, with respect to claims 2, 8 and 14, Appellant argues that "VAN dose not disclose model agreements in a plurality of languages... [instead] VAN discloses having software in a plurality of languages for negotiation purpose and not for contract generation purpose" and also argues that "combining VAN into Luchs is no more than hindsight reconstruction." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Note that Luchs teaches generating the model agreements. The prior art of VAN is only used to show that implementing in a plurality of languages for creating a legal communication system was well known. Furthermore, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, a

person of ordinary skill in view of Luchs and VAN would have appreciated the benefit of implement Luchs system in to create the contract in a plurality of languages.

On pages 19-20, with respect to claims 4, 10 and 16, Appellant argues that "Grubb's 'alternate clauses' are essentially the same as Luchs' paragraphs." As explained with respect to claims 6, 12 and 18 above, the argument is not persuasive. Appellant may think that the Grubb's system is "essentially the same" but Examiner disagrees with the subjective opinion.

As per claims 5, 11 and 17, Appellant argues that "Examiner has not cited a prior reference that teaches or suggests indexing the alternate clause by type of clause.. [and thus] has not .. establish a prima facie case of obviousness." Examiner disagrees. Examiner pointed out that the feature was "well known in the art at the time of the invention." Appellant throughout the prosecution did not object the assertion that it was well known. If the assertion were made, Examiner would have provided a hard reference. Even now, Appellant is not objecting that it was well known. Rather, Appellant points out that there was no reference used. There is no requirement that a reference must used as long as it is agreed that certain features are well known.

On pages 21 and 22, Appellant argues that the rejection of Claim 20 by the Examiner is "generic and non-specific." However, as explained with respect to claims 13, the argument is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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March 8, 2004

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